

### REMARKS

Claims 1-7 are pending and at issue. All claims stand rejected under various rejections. The first rejection is a provisional double-patenting rejection based on co-pending Application No. 10/393,671. Because the rejection is provisional, there is no obligation to respond. The second rejection is a new rejection under 35 U.S.C. §103 based on Uchiya (U.S. Patent No. 6,579,606) in combination with Nitta et al. (U.S. Patent No. 5,800,909). The applicants have carefully considered this prior art rejection and respectfully traverse in light of the remarks outlined below.

The application includes three independent claims, claims 1, 4 and 7 and each recite colloidal silica. Claims 1 and 4 recite, *inter alia*, a light diffusing sheet including a transparent base sheet and a light diffusing layer provided on a front surface side of the base sheet. Claim 1 further recites the light diffusing layer is formed by dispersing resinous beads and a fine inorganic filler into a binder. The fine inorganic filler is "colloidal silica having an average particle diameter that is in the range of 5 nanometers to 50 nanometers." Claim 4 recites a sticking proof layer formed by dispersing resinous beads and a fine inorganic filler into a binder, where the fine inorganic filler is also "colloidal silica having an average particle diameter that is in the range of 5 nanometers to 50 nanometers." Claim 7 recites a backlight unit including, *inter alia*, a light diffusing layer formed of dispersing resinous beads in a fine inorganic filler into a binder, where the fine inorganic filler is "colloidal silica having an average particle diameter that is in a range of 5 nanometers to 50 nanometers." None of the prior art teaches or suggests the recited subject matter.

The office action rejects each of these independent claims based upon Uchiya, which the office action concedes does not teach colloidal silica, and Nitta. Uchiya et al. does describe a backlight reflection sheet for use in a liquid crystal panel. The reflection sheet comprises a mixture that includes a small particle balloon having a particle diameter of between .05 to 10 microns (i.e., above 50 nanometers), but Uchiya does not disclose any colloidal silica. Instead, the office action points to Nitta for such teaching. Nitta teaches an illumination, transmission sheet that has a layer in which colloidal silica is used to produce color dyes. But Nitta nowhere teaches using colloidal silica in the claimed structure, nor does Nitta teach the use of colloidal silica having particle diameters in the range of 5 nanometers to 50 nanometers.

The office action fails to point to any teaching, suggestion or motivation in the prior art to combine the teachings of Nitta and Uchiya. Thus the office action fails to establish the requisite *prima facie* obviousness.

To establish *prima facie* obviousness, there must be some teaching, suggest, or motivation from the prior art to make the proposed combination or modification. One cannot rely upon the mere fact that references can be combined or modified, unless the prior art also suggests the desired combination. MPEP §2143.01 *citing In re Mills*, 916 F.2d 860 (Fed. Cir. 1992). Nor may one maintain a rejection based on the notion that the claimed subject matter was within the capabilities of one of ordinary skill in the art. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993) (stating that a rejection that the claimed inventions would have been well within the ordinary skill of the art at the time the invention was made is not sufficient to establish a *prima facie* case of obviousness). As explained by the Federal Circuit in *In re Rouffet*:

As this court has stated, virtually all [inventions] are combinations of old elements. Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue...To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

*In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (citations omitted and emphasis added). As further explained in the *In re Rouffet* decision:

This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, at 1458.

The office action points to none of these sources for a motivation or suggestion. And, as such, the obviousness rejection is legally flawed and improper.

The office action suggests that the colloidal silica of Nitta would have been obvious to use in Uchiya to enhance brightness. Yet, the office action fails to show where the prior art suggests that motivation or any expectation of success in making that proported combination, as required. In re Royka, 490 F.2d 981, 984 (CCPA 1974). As instructed many times, both the suggestion to try and the expectation of success must be found in the prior art, not in the applicant's disclosure. Amgen Inc. v. Chugai Pharmaceutical Co. Ltd., 927 F.2d 1200, 1207 (Fed. Cir. 1991), citing In re Dow Chemical Co., 837 F.2d 469, 475 (Fed. Cir. 1988).

In fact there would be no suggestion or motivation to use the colloidal silica of Nitta in the sheet of Uchiya. The office action points to two different and disparate descriptions in Nitta in an attempt to suggest that somehow Nitta discloses colloidal silica as a fine inorganic filler, which may be used in Uchiya. First, the office action points to column 2, lines 40-54 of Nitta as describing fine white (inorganic) particles. This, of course, is a description of the microporous film layer (II) of Nitta, which is laminated to a plane weave fabric (I). See, FIG. 2. This layer is entirely different from the layer Nitta describes as having colloidal silica. Colloidal silica in Nitta is only used as an inorganic acid material that is combined with basic dyes to form color in the separate, image recording/receiving layer (III). The office action appears to misread this description of an inorganic acid material as being an example of the separately-described fine inorganic particle materials of the microporous file. The two are entirely different. In fact, the applicants note that Nitta lists its layer II, fine inorganic particles at column 6, lines 7-11 and makes no mention of colloidal silica.

In short, there is no teaching or suggestion within the art to make the proported combination, and, as such, the office action fails to establish *prima facie* obviousness. Additionally, the office action has mis-applied the disclosure in Nitta, and a correct application shows that there would be no teaching or suggestion to combine Nitta and Uchiya in the way suggested.

Additionally and separately, the applicants note that even assuming, *arguendo*, there was a suggestion to combine, which there is not, the proported combination still would not render obvious the recited subject matter. Each of the independent claims recites a fine

inorganic filler that is colloidal silica "having an average particle diameter that is in a range of 5 nanometers to 50 nanometers." Nowhere does the prior art teach a colloidal silica having the recited average particle diameter. Thus, even if a suggestion to combine existed, which it does not, the combination simply would not teach the recited subject matter.

In view of the above, each of the presently pending claims (1-7) in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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